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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,532	06/01/2001	Daniel J. McGurran	56763USA2A.002	3298

32692 7590 09/07/2006

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,532

Applicant(s)

MCGURRAN ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 11, 13-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 11, 13-19, 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

D. LAWRENCE TARAZANO
PRIMARY EXAMINER



Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

1. **Sheba Ahmed is out of the office on extended leave. In order to meet statutory time requirements, the examiner of record has changed; D. Lawrence Tarazano is now the examiner in this application.**

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/2006 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description requirement**. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants fail to have support for “oriented films” with in the claimed range.

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process conditions under which the body is formed. Typical casting thicknesses range from about 0.3 mm to as much as 3.0 mm, though, depending on the particular end use, thinner or thicker castings can be made.

5. The thickness claimed is for “oriented” films, the specification lists thickness of 0.3 to 3.0 for “cast films”. A film is cast at a particular thickness; the process of orientation decreases the thickness of the film relative to the increases in width and length of the film (conservation of matter is obeyed). Once oriented the cast film is oriented, it could not possibly have the claimed thickness range. There is NO support for this limitation as claimed.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1, 2, 10, 11, 13-19, 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The applicants claim the limitation “exhibits a transmission of light within a wavelength band of interest within the visible spectrum of from 5% to 90%”. Without clearly setting forth the wavelength band, the claim is indefinite. One working in the field would have no idea how to determine if their films infringed upon the claimed films. One has no idea what wavelength to use for comparison; what may be of “interest” to the applicant may not be the same as what is “interest” to another party.

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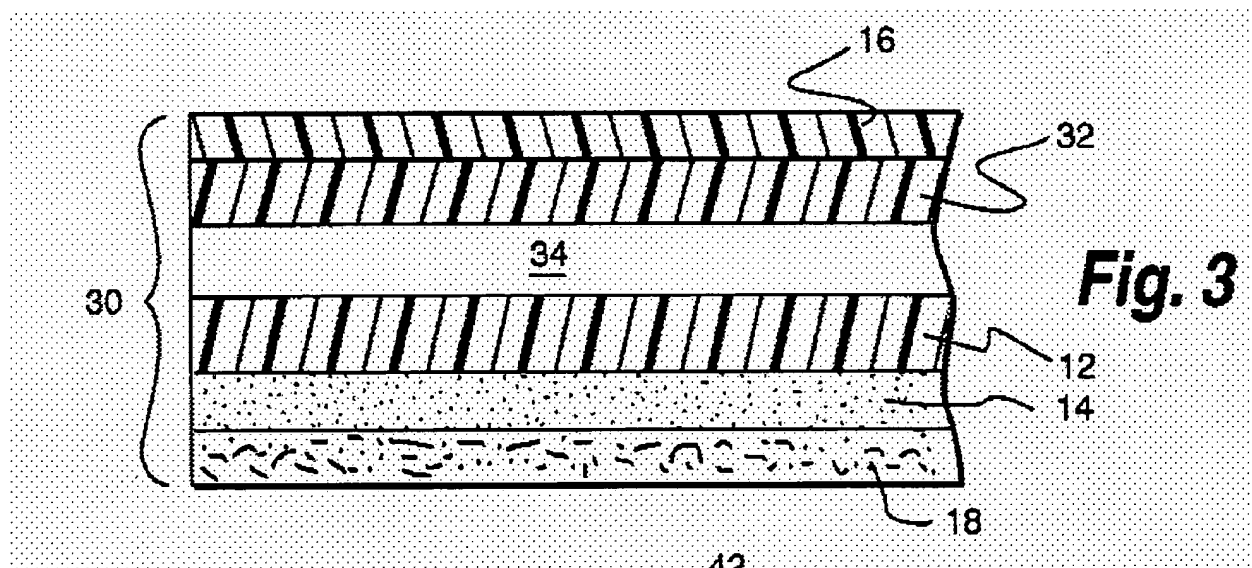
Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 10, 11, 13-19, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enniss et al. US 2006/0003158 or 6,440,551 (having an effective filing date of June 14, 1999) alone or in view of Oliver et al (4,634,637) or Marks et al. (3,298,959).

11. Enniss et al. teach laminate film structures, which comprise layers containing pigments and layers containing dyes so that the over all color of the film is improved [006].



12. These Structures contain a film layer, which is colored with blue and red dyes (12) and a color matching layer (14) which contains a pigment [0029], wherein the a gray composite results.

13. The pigment may be in the adhesive layer (14) or in an additional film layer (e.g. 32) [0034].

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14. The films have will have haze values of less than 25%, preferably not greater than 5% (printing error in the pre-grant publication [0035], see 6,440,551 for evidence of content; column 6, line 8).

15. The film layers are made of thermoplastic resins such as polyester [0021].

16. The pigments have particle size of less than about 10 microns. Preferably less than about 0.5 microns [0026] and can be virtually any pigment that satisfies the criteria of the invention, wherein the size of the pigments is directly related to the amount of haze. Small pigment particles produce less haze [0027].

17. The film have a^* and b^* values within the values of -5 to 5 as claimed see Example 1. Given the teachings of Enniss et al., it would have been obvious to one having ordinary skill in the art to arrive at a film having the claimed properties. They clearly teach how to use dyes and pigments in the same films, how to produce films having low haze, etc... The amount of pigment and dye would be directly related to the blocking desired.

18. Regarding the degree of transmission within a waveband of interest in the visible spectrum of 5% to 90%, based on the materials used and the construction of the film, taking into consideration the use of the film, the film would have this property.

19. Regarding the use of carbon black, this is an old pigment, which gives a gray color. It would have been obvious to use carbon black in the structure described by Enniss et al, as it is a stable black pigment. The examiner relies upon Marks et al. (figure 2) and Oliver et al. (column 3, lines 55+) to show that carbon black is conventionally used in optical films as a pigment resulting in a gray film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used carbon black as a pigment to produce gray structure.

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20. Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have placed the dye and pigments in the same layer as opposed to two separate layers as this would reduce the number of separate layers need and make a more economical film.

21. Regarding claims 22 and 23, given that these claims are generic to any dye that can be polymerized with the polymer, the examiner takes the position that the applicants are taking the position that polymerizing dyes in the polymer structure is of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used dyes having polymerizable groups, as they would become permanently part of the structure.

22. Regarding claims 26 and 27, polyester films are conventionally cast and oriented to make them thinner and stronger. It would have been obvious to orient the polyester films taught by Enniss et al. to produce thinner, stronger films.

Response to Arguments

23. Applicants' arguments with respect to claims 1, 2, 10, 11, 13-19, 21-27 have been considered but are moot in view of the new ground(s) of rejection. The examiner has withdrawn the previous rejection in view of the applicant's declaration and refined the "written description" rejection to clearly point out the lack of support for the claimed structure.

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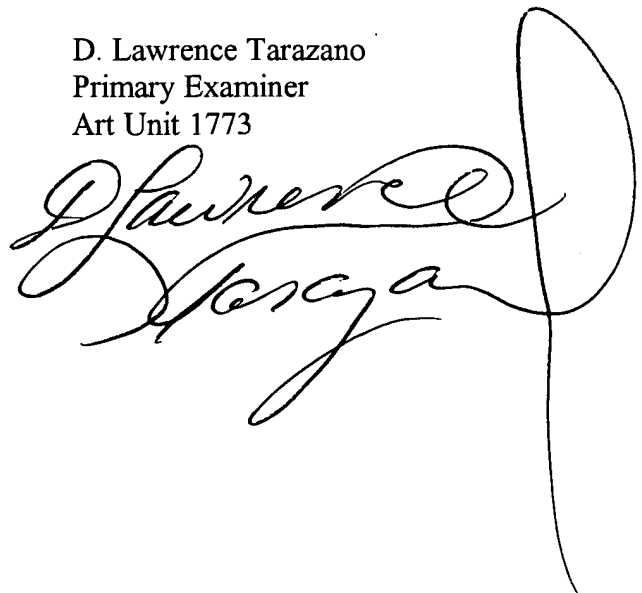
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

D. Lawrence Tarazano
Primary Examiner
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A handwritten signature in black ink, appearing to read 'D. Lawrence Tarazano', is written over the typed name. The signature is stylized with a large, looping 'D' and a long, sweeping underline that extends to the right.